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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/535,613

01/12/2006

Henry Kister

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24392 7590 12/08/2009

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EXAMINER

MANOHARAN, VIRGINIA

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

12/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/535,613 | Applicant(s) KISTER ET AL. | |
| | Examiner Virginia Manoharan | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-20 is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steacy (6,558,515) with or without Shinskey (4,358,346)

Steacy and Shinskey are applied for the same combined reasons as set forth at page 3 of the previous Office Action.

Claims 11-20 are allowed.

Applicants' arguments filed August 12, 2009 have been fully considered but they are not persuasive.

Applicants' arguments such as : "...the vapor pressure cell in the '346 patent does not measure the concentration of the first component, but the pressure differential of the vapor flow (comprising first and second components). In other words, Steacy's pressure cell measures hydrodynamic pressure, whereas the DVP cell of measures vapor pressure of a fluid within the cell. Second, it is noted that Steacy's pressure sensor is disposed on the top tray of each section. In contrast, the DVP cell of the claims is located below the feed point of the ternary mixture. Such location is of significance as under ordinary operating conditions the first component should not travel in any significant quantities to a point below the feed as the first portion is in the rising vapor"

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are not persuasive of patentability because of the following reasons:

The argued "Steacy's pressure cell measures hydrodynamic pressure, whereas the DVP cell of measures vapor pressure of a fluid within the cell" relied upon by applicants to distinguish over Steacy is process or functional language. Steacy's apparatus possesses the capability of performing either of the above functions. A claimed apparatus must be distinguished from the prior art apparatus on the basis of structure. Therefore, the patentability of an apparatus claim depends only on the claimed structure, not on the use or purpose of that structure, *Catalina Marketing Int'l., Inc. v. Coolsavings.com Inc.*, 289 F.3d 801,809 (Fed. Cir. 2002), or the function or result of that structure. *In re Danly*, 263 F.2d 844, 848 (CCPA 1959); *In re Gardiner*, 171 F.2d 313, 315-16 (CCPA 1948).

Steacy and Shinsky disclose the concept of using a DVP cell in the field of distillation. Given that concept (*In re Bascom*, 230 F.2d 612, 109 USPQ 98 (CCPA 1956)) one having ordinary skill in the art would have been led to modify the apparatus of the prior art motivated with the reasonable expectation, inter alia, of measuring concentration of desired component. Applicants fail to delineate structures not shown nor renders obvious by the prior art. Furthermore, whether the argued pressure sensor is disposed on the top tray of each section as in the prior art, or located below the feed point of the ternary mixture as claimed is of no patentable moment. Shifting to a different position is an obvious design since the operation of the DVP cell would not be modified either way, and since the claimed first component is so broadly recited it would read on any of the

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prior art components that would not travel in any significant quantities to a point below the feed.

Absolute predictability is not a prerequisite for obviousness rejection. All that is required to show obviousness is that the applicant make his claimed invention merely by applying, knowledge clearly present in the prior art. Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor. See *In re Winslow*, 53 CCPA 1574, 1578, 365 F.2d 1017, 1020, 151 USPQ 48, 50-51 (1966). No commercial success is claimed, nor is any other factor indicating. No commercial success is claimed, nor is any other factor indicating non-obviousness is seen to exist.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia Manoharan whose telephone number is 571-272-1450.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola, can be reached on 571-272-1444.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Virginia Manoharan/
Primary Examiner, Art Unit 1797